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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,915	10/12/2001	Fujio Mori	2001-1552	9963

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EXAMINER

RESAN, STEVAN A

ART UNIT PAPER NUMBER

1773

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,915

Applicant(s)

MORI ET AL.

Examiner

Stevan A. Resan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

OBJECTIONS TO CLAIMS

2. Claims 1-3 recite the term "kinds of" which may render the claims indefinite. See MPEP 2173.05(b) Ex parte Copenhaver 109 USPQ 118 (BPAI 1955). The examiner suggests deleting this phrase.

Claims 11 and 12 use the term "into a cavity". It is not clear if the cavity is the mold per se or a cavity within the mold. Applicants are requested to clarify on the record.

3. The amendment filed 28 August 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "formed by extrusion" introduced into claims 1-3.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 3-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no description of a transparent acrylic film formed "by extrusion" nor teachings that this was a critical feature of the invention.

7. Claims 1, 3-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a transparent acrylic film, does not reasonably provide enablement for one formed "by extrusion". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

8. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons of record and as further explained below.

Claim 2 remains indefinite because of the recitation "replaced with the acrylic resin" in line 8. There is insufficient antecedent basis for "the acrylic resin" in the claim and furthermore it is not clear if applicants are claiming a polycarbonate film, a polycarbonate copolymer film or a polycarbonate laminate film (including or excluding an acrylic resin) as the transparent film laminated on the bonding surface side film.

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9. Claims 1, 3-6, 9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellison et al US 5536539 for the reasons of record.
10. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Ottawa et al US 4997707 for the reasons of record.
11. Claims 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Spain et al US 5725712 for the reasons of record.
12. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellison et al as applied to claims 1,6 in view of Ijichi et al WO 97/44389 and Gownder et al US 5908594 for the reasons of record..
13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellison et al US 5536539 as applied to claims 1,9 in view of Paddock US 4440825 for the reasons of record..
14. Applicant's arguments filed 28 August 2003 have been fully considered but they are not persuasive.

Applicants argue that Ellison discloses a cast sheet but fails to disclose one formed by extrusion. In response the examiner points out that the method of formation is a process limitation. Process limitations carry no weight in article claims unless they can be shown to produce a patentably distinct article. It has been held that where claimed and prior art products are identical or substantially identical in structure or in composition, or are produced by identical or substantially identical processes a case of anticipation or a prima facie case of obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or

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inherently possess the characteristic of a claimed product whether the rejection is based upon "inherency" under 35 USC 102 or on "prima facie obviousness" under 35 USC 103 jointly or alternately. In re Best 562 F2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); In re Ludke, 58 CCPA 1159, 441 F 2d at 212-13, 169 USPQ 563 (1971); In re Brown, 59 CCPA 1036, 459 F. 2d 531, 173 USPQ 685 (1972).

While applicants have claimed a "foil decorating sheet", a sheet which is later bonded to a resin during injection molding is not considered a claim limitation ("to be bonded", "for being integrally bonded", "which is to be set", are considered as intended uses for the sheet. Hence properties deriving from the finished molded article such as peel strength are not a claim limitation for the presently claimed article.

With respect to the traversal of the rejection based upon Spain applicants argue that " there is defined an acrylic resin which does not include fluoropolymer" however claim 3 given its broadest interpretation does not exclude an acrylic film containing a fluoropolymer. Furthermore finding the members of a class of prior art polymers which are best suited for a particular purpose is not a patentable invention. Ex parte Fauser (POBA 1953) 128 USPQ 156.

A generic disclosure of the prior art directed to a recognizable small class of compounds having common properties which embrace the claimed compounds, is anticipatory notwithstanding the fact that the claimed compounds are not specifically named. In Re Schaumann et al (CCPA 1978) 572 F2d 312, 197 USPQ 5.

However the examiner deems that patentable subject matter may be present based upon the results of Figure 5, paragraphs [0043], [0046]. Applicants are

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encouraged to file an RCE and to thereafter contact the examiner for an interview to discuss the scope of a claim, which after further search, may be allowable.

15. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

16 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is (703) 308-4287. The examiner can normally be reached on Tues-Fri from 7:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718


STEVAN A. RESAN
PRIMARY EXAMINER